

Applicant : Harald Schaty  
Serial No. : 10/779,771  
Filed : February 18, 2004  
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Attorney Docket No. A-10035

### **REMARKS**

Pursuant to entry of this amendment, claims 1-4 and 7-20 are pending in the application. Claims 5 and 6 have been cancelled and claims 12-20 have been newly added.

#### **Claim Rejections – 35 U.S.C. §102**

Claims 1-4 and 7-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nakajima et al. (WO 01/02316 with translation U.S. Patent No. 6,863,956)

Applicant respectfully traverses.

Independent claim 1 recites that the disk-shaped object includes a central hole. The Examiner acknowledges that Nakajima fails to disclose a device which includes a central hole. Nevertheless, citing MPEP 2144.04 (I) and (IV), the Examiner asserts that it would have been an obvious matter of design choice to modify Nakajima so that it was annulus shaped with a central hole. However, it would not have been obvious to modify Nakajima as suggested by the Examiner and MPEP 2144.04 (I) and (IV) are not applicable to this situation.

Nakajima is directed to an interlayer for laminated glass. There is no indication that a hole would be desirable in a laminated glass interlayer and the Examiner has provided no evidence that a hole in glass interlayers is known or desirable. The present application includes a non-limiting exemplary embodiment directed to using a disk-shaped thermoplastic material as an intermediate between parts such as a fastener and a plate-shaped part (*see* the exemplary embodiment of Fig. 3). In such an exemplary embodiment, a hole 4 is clearly a useful structural feature. However, Nakajima is

directed to an interlayer in laminated glass and there is no reason why it would have been obvious to provide a hole in a laminated glass interlay. In fact, the Nakajima interlayer is designed to keep two pieces of glass together when glass breaks (*see* column 1, lines 17-24). The inclusion of a hole would provide for an undesirable gap in the interlayer at which the glass would not be held together.

Furthermore, the MPEP sections cited by the Examiner are inapplicable to the present case. For example, MPEP 2144.04 (I) cites one case, *In re Seid*, for the proposition that if a shape is an ornamentation which has no mechanical function, the shape cannot be relied upon for patentability and a counterpoint case, *Ex parte Hilton*, which held that particular shape of the product in that case was important, and therefore relevant to patentability. The present case is not similar to the *In re Seid*. Particularly, in this application, the hole is not a mere ornamentation at all. Rather, the hole serves a mechanical function and allows the disk 1 to be used as an intermediate between structural parts. For example, in the non-limiting exemplary embodiment of Fig. 3 of the present application, the object 1 is used as an intermediate between the flange 21 of a fastening element 22 and the plate-like part 20. The hole in the object 1 allows it to serve as such an intermediate member. It is clearly not merely an ornamental feature, but serves a mechanical purpose. Accordingly, *In re Seid* and MPEP 2144.04 (I) are inapplicable in the present case.

The Office Action also cites MPEP 2144.04 (IV) as an alleged basis for the proposition that it would have been obvious to modify Nakajima to include a hole. However, MPEP 2144.04 (IV) is also inapplicable. The hole is not merely a matter of

design choice, but serves the purpose of allowing it to serve as an intermediate between parts, such as the fastening element 22 and plate-like part 20 shown in the exemplary embodiment of Fig. 3.

Additionally, the Examiner's citation of various other patents is irrelevant to the issue of whether it would have been obvious to modify Nakajima to include a hole as claimed. That, for example, an orthodontic appliance (Jacobs et al.) may have a different shape than the laminated glass interlayer of Nakajima simply provides no basis for the modification the Examiner suggests. The shape of an orthodontic appliance (or other unrelated device) provides no guidance for the shape of an interlayer for laminated glass.

In view of the above, Applicant submits that it would not have been obvious to include a hole in the interlayer for laminated glass of Nakajima. Accordingly, Applicant submits that claim 1 is allowable over Nakajima.

Claims 2, 4 and 7 depend from claim 1 and are allowable at least by virtue of their dependency.

Independent claim 8 recites that the arithmetic mean rugosity of the object lies in a range from 6 to 25  $\mu$ . The Examiner does not assert that Nakajima discloses an arithmetic mean rugosity as claimed. Instead, citing MPEP 2144.05 (II), the Examiner asserts that such a feature would have been obvious because it would involve discovering an optimum or workable range. However, as explained in the MPEP section cited by the Examiner, a particular parameter must first be recognized as a result-effective variable before it can be optimized (MPEP 2144.04 (IV)). The Examiner has not even asserted that Nakajima discloses any particular arithmetic mean rugosity at all, let alone that

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Nakajima discloses that it is a result-effective variable which can be optimized. At least because Nakajima does not disclose that arithmetic mean rugosity is a results effective variable, the Office Action's reliance on MPEP 2144.05 (II) is misplaced. Therefore, the Office Action provides no valid rationale as to why it would have been obvious to modify Nakajima to meet claim 8 and claim 8 is allowable over Nakajima.

Claims 9-11 depend from claim 8 and are allowable at least by virtue of their dependency.

#### **New Claims**

Claims 12-20 have been newly added herewith. Claim 12 depends from claim 1 and claim 13 depends from claim 8. Accordingly, claims 12 and 13 are allowable at least by virtue of their respective dependencies.

Claim 14 is allowable at least because Nakajima fails to disclose an assembly as recited therein. Claims 15-20 depend from claim 14 and are allowable at least by virtue of their dependency.

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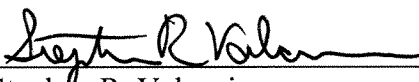
**Conclusion**

Applicants do not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, Applicants have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application.

The USPTO is directed and authorized to charge the two(2) month extension of time fee to Deposit Account No. 02-2550. The USPTO is also authorized all required fees, except for the Issue Fee and the Publication Fee, to said Deposit Account. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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